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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BAS ORDING, STEVEN P. JOBS,
and DONALD J. LINDSAY

Appeal 2007-4296
Application 09/467,074
Technology Center 2100

Oral Hearing Held: January 17, 2008

Before HOWARD B. BLANKENSHIP, ALLEN R. MACDONALD, and JEAN R. HOMERE, *Administrative Patent Judges.*

ON BEHALF OF THE APPELLANTS:

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P R O C E E D I N G S

JUDGE BLANKENSHIP: Whenever you like.

MR. LABARRE: Good morning. The, the invention that is the subject of the present application is a graphical user interface for computers. And, more specifically what it deals with is a, is a bar or light that the user

of the computer employs to quickly locate and provide quick access to applications, folders, files, websites, things that, that the user wants to be able to pull-up quickly. And, what the invention really deals with is the fact that with the, the increased capability of computers and the wide variety of applications that are available on -- for computers now, many users will have many different applications, many different windows, many different folders sets of data. They want to keep open and available to them all the time. So, the problem becomes we can have this bar we have access to all these various materials. How do you accommodate this large number of items in a limited space of the display screen? So, what the, the application is really directed to is a behavior of the bar that accommodates this problem. The bar is perhaps similar to the task bar that you might be familiar with Windows at the bottom whenever you collapse a window or you have an application there's a button on the bottom. The actual implementation of the invention, you can see in the Macintosh user interface. I don't know if any of you are familiar with Macintosh, but that has an area at the bottom that's called the dock and it provides you with access to, to your applications, files, websites and the like. The features that are most relevant to the broad claims, at least, are depicted in Figures 6 and 7 of the application.

Unfortunately, as with many user interface items, since these are static figures; they don't really bring out the full appreciation of what this claim concept relates to. I do have a live demonstration on a laptop that I can show you if you'd like to see it today. It gives a better feel for what the invention actually is.

JUDGE MACDONALD: Actually, no.

MR. LABARRE: Okay.

JUDGE MACDONALD: We can't do that.

MR. LABARRE: I mean, it would only take a minute, but I can understand that.

JUDGE MACDONALD: It isn't, it isn't the time issue that it wouldn't be. It would not be in the record.

MR. LABARRE: Well, let me address that that particular issue. There was a, a information disclosure statement that was submitted in, I think, November of 2001 and in that information disclosure statement or accompanying that were screen shots of this demo. And, the information disclosure statement also referred to a compact disc that could be provided to the Examiner if he wanted to see the light demo. The Examiner never actually asked for it, so it sort of in the record, although he never actually saw the demo. But, I understand if you don't want to see it because of that.

JUDGE BLANKENSHIP: I think we understand the invention.

MR. LABARRE: Okay. So, basically what it is is the idea that you may have a bar with a number of these they're referred to as tiles in the, in the application. You might also think of them as icons; that because you have a large number of them, they're reduced down in size so you can fit them all across the screen. And, the idea is that when you bring the cursor close to this bar, the icon that is closest to your tile that is closest to it expands its size so you can really get a good appreciation of it. And, one of the very nice aspects of it is that it's a dynamic feature so as you move the cursor across the screen, it's almost like a wave, and you see these certain icons increasing in size and others decrease in size.

JUDGE MACDONALD: That was -- I don't recall that that's in, in the independent claims. Is it the --

JUDGE HOMERE: Yeah, it is.

JUDGE MACDONALD: I thought only every independent claim was limited to only one is increasing in size.

JUDGE HOMERE: Yeah well, some of the independent claims captured that, but --

JUDGE MACDONALD: Say again.

JUDGE HOMERE: Some, independent claims capture that; others don't. It's captured as repositioning.

JUDGE MACDONALD: Oh, okay.

JUDGE HOMERE: Repositioning the other tiles --

JUDGE MACDONALD: Repositioning, yes, but increasing in size, I don't recall seeing that in the independent --

JUDGE HOMERE: Oh, no, no, no.

MR. LABARRE: That would be if you refer, for example, to Claim 71. That's one of the independent claims. It talks about a varied magnification of plural tiles; I believe is the term it uses. It's the very last clause of Claim 71. It says selectively magnifying at least one of said items closest to said cursor to a first level and magnifying items proximate --

JUDGE MACDONALD: Okay.

MR. LABARRE: -- to said one item to other levels less then first level. So, that's kind of the peak of the wave. So, the first level would be the top of the wave where the cursor is located and the ones on either side of

it are magnified a little bit less. And, as you get farther away from the cursor --

JUDGE MACDONALD: Okay.

MR. LABARRE: -- less magnification.

JUDGE MACDONALD: But, it's not in the other independent claims prior to 61?

MR. LABARRE: I believe that's the first independent claim that brings out that concept, yes.

JUDGE MACDONALD: Thank you.

MR. LABARRE: Okay. So, the issue that, that really I want to discuss with you today is the rejection of the claims under 35 U.S.C. 103 based on two principle references. Now the briefing in this appeal was done prior to the Supreme Court's decision in KSR, and so the briefs are addressed to the teaching suggestion motivation standard that was in place at that time. And, that's why I wanted to come in on an oral hearing to talk about the fact that in their decision in KSR, the Supreme Court basically relaxed that standard; made it less rigid in their terms.

But, in doing that, they did not totally eviscerate some requirement for combining references. They still required some reason bases for putting the references together, and if I might just quote from one passage in KSR. The Court stated, "Rejections on obviousness grounds cannot be sustained by mere conclusory statements, instead there must some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." So, I think that still has to be kept in mind as you look at the rejection, even in light of the Supreme Court's decision. And, and, we

basically submit that even with the more relaxed standard, the rejection does not meet the necessary criteria.

So, turning to the references; there's the Selker (phonetic sp.) reference is basically directed to the same area of technology. It's got what they call an icon menu bar. In their car it's at the top of the screen, but where it's located is irrelevant. And, basic idea behind that is as you bring a cursor closer to this bar of icons, one of them will expand in size. So, it enables you, in terms of the patent, to capture that icon or conversely for the icon to capture the cursor as the cursor comes closer to it. So, the user can select the application or whatever object is associated with that expanded icon.

JUDGE MACDONALD: Could you explain how, with respect to the 102 rejection, how Claim 30 -- how 35 is not anticipated by the reference?

JUDGE HOMERE: It's a 103.

JUDGE MACDONALD: I'm sorry, I thought, I thought the rejection --

JUDGE HOMERE: No, a miscommunication. Yeah, 103 was based on the two references.

JUDGE MACDONALD: My fault, sorry, could you explain why -- sorry, why Claim 35 is not obvious then over the references? I recognize that Claim 35 is broader than 1, but that's, that's why I'm interested in 35.

MR. LABARRE: Okay. Claim 35 recites a computer system comprising a display a cursor means for pointing to position within said display the user bar rendered onto the display and having plurality of tiles associated there with --

JUDGE MACDONALD: After that point I'm assuming that's the prior art.

MR. LABARRE: That's in Selker, definitely. So, the, the distinguishing aspect is a processor means for varying a position of at least one said plurality of tiles on said display.

JUDGE MACDONALD: Can I stop you there for a second? I'm assuming that, looking at Selker, is in Selker.

MR. LABARRE: I would contest that. Selker keeps the icons in the same position. What it does is it enlarges the size of the one icon that is closest to the cursor. So, if, for example, when you go through the sequence of steps; here's 1, 2 and 3-A of Selker. Basically, what that's showing is the user is bringing the cursor within the proximity of the icon bar, and the icon that's closet to it is the one that's labeled K. And, as the cursor gets closer to that, the K icon expands in size. It's basically shown by the question mark. I'm not sure why they use that designation, but that's what's expanding size. So, its position on the screen is remaining the same, it's just its size that's expanding.

JUDGE MACDONALD: Well, isn't that kind of subjective to say its position stays the same. I'm looking at the bottom right hand corner of the icon and it certainly seems to be changing its position.

MR. LABARRE: Well, I guess that comes down to your interpretation of the word position.

JUDGE MACDONALD: Exactly.

MR. LABARRE: I think the, the --you know, it's, it's -- whatever the reference location is for the icon stays the same, it's just expanding in size relative to that reference like location.

JUDGE HOMERE: In the invention itself, the position is defined as what exactly?

MR. LABARRE: Pardon me.

JUDGE HOMERE: The position in the invention itself, you say the claim calls for a processing the means for varying the position for at least one of plurality of tiles. Do you not mean that as the cursor gets close to the bar, to a particular tile on the bar that, the tile starts expanding?

MR. LABARRE: The term position is not referring to the expansion per se of a particular tile. What we're really talking about is -- if you go to say Figure 6.

JUDGE HOMERE: Yes.

MR. LABARRE: And, this particular example is where the cursor is over the icon that's labeled the clock.

JUDGE HOMERE: Okay.

MR. LABARRE: So, if you look, for example, at the right hand icon that's labeled 640, you see where its position is on the bar at the bottom of the screen? Then if you move to Figure 7 where the user has moved the cursor to the right across the screen, so now it's a different icon that's enlarges. So, the clock icon over towards the left side is now smaller. And, you see now the right side of the screen is filled up because other icons have moved to the right basically to accommodate the fact that this new icon has been expanded.

JUDGE MACDONALD: So, what I'm, what I'm hearing in art of discussion of Claim 1, Alms (phonetic sp.) discussion of Claim 1 we understood the repositioning that's mentioned there (indiscernible) to makes it a little clearer for the record. The icon that's to be expanded, let's call it the primary icon and all the other icons are secondary icons. In Claim 1 as the primary icon expands, the secondary icons are moved aside.

MR. LABARRE: Exactly.

JUDGE MACDONALD: And, Claim 35 the repositioning you're talking about the secondary icons at that point.

MR. LABARRE: That's right.

JUDGE MACDONALD: Okay.

MR. LABARRE: The movement of those icons -- and that, that particular aspect is probably brought out better in the sequence if you use 8-A though 8-D.

JUDGE HOMERE: But, I believe that the scope of Claim 1 -- of Claim 35 seems to be rather broader than that. I think that this is a narrow construction; narrow interpretation of Claim 35 here. Another way of looking at it, I think, is that as the cursor moves closer to the bar, okay, so the icon or the tile that's, that is closest to it pretty much expands.

JUDGE MACDONALD: Yeah, I think all -- the bullet point I was making was that was the Appellant's interpretation.

JUDGE HOMERE: Okay.

JUDGE MACDONALD: Sorry. Not that we have to review it then --

JUDGE HOMERE: Okay.

JUDGE MACDONALD: -- only that that was the Appellant --

JUDGE HOMERE: Okay.

JUDGE MACDONALD: -- knowing their starting position helps us --

JUDGE HOMERE: Okay.

JUDGE MACDONALD: -- clarify what we're -- our thinking and when we make a decision.

JUDGE HOMERE: I see.

MR. LABARRE: Basically, what comes out in the claims there are two kinds of behavior, if you will, that primarily characterize what's going on; one is the magnification, change in size so that icon that's closest to the cursor jumps up to a certain defined maximum size, and then other icons adjacent that expand in size. And, the second aspect of the behavior is the movement of the icons. So, as one is expanding, the others move away from it to accommodate the increased size of that, that first icon. And, that's one of the distinctions over the Selker reference is that it doesn't disclose this movement of the other icons so that the entire bar is still visible. Rather what it does it the one who's expanding, basically, covers up its neighbors as it expands more and more.

JUDGE MACDONALD: Essentially, you're saying the secondary icons in Selker are not deemed to have the same value you're placing on them, so they're just covered up?

JUDGE BLANKENSHIP: It, it's not so much the value, I think. It's just the visual effect that's created. As I said, it's kind of in, in the invention, it's kind of this wave. As you move the cursor across you'll see

1the crest of the wave following the cursor. And, so rather than just the one
2cursor or one icon expanding, it's multiple icons. So, it's a more symmetric
3effect. Whereas in Selker, it's just the one that's closest to it expands so you
4can capture that one. Now, what Selker does disclose, is that if you move
5the cursor the distance of one of the unexpanded icons, then the next one
6will roll and expand in its place. And, that's shown with reference to
7Figures 3-A and 3-B. So, they show where they -- essentially the K icon is
8expanded in 3-A and then by moving the cursor slightly to the right, the L
9icon enlarges and the K collapses.

10 JUDGE HOMERE: Going back to Claim 35, would you agree that
11that last step does not actually require that the other icons will be reposition.
12All that's required for this limitation to be met is that once the cursor gets
13close to a particular tile, that tile -- the position of that tile is varied?

14 MR. LABARRE: Well, it doesn't require that it be the one tile that
15it's closest to.

16 JUDGE HOMERE: But it says one tile.

17 MR. LABARRE: Right:

18 JUDGE HOMERE: So, any, any tile.

19 MR. LABARRE: Any tile.

20 JUDGE HOMERE: Including, including the one that's closest to it.

21 MR. LABARRE: Exactly, exactly right, yes.

22 JUDGE HOMERE: Okay. Therefore, would you not agree that
23Selker by itself seems to teach this entire claim as it is?

MR. LABARRE: Well, it comes back to that definition of in position. My, my interpretation is that it's remaining in the same position. It's at the same location, just a bigger size.

JUDGE MACDONALD: It's the issue of determining does the specification sufficiently limit that term to only the interpretation that the Appellant is giving it.

JUDGE HOMERE: Okay.

JUDGE MACDONALD: Whereas the Examiner's interpretation is also valid.

MR. LABARRE: I'm not sure the Examiner actually addressed that particular issue in the rejection.

JUDGE MACDONALD: Well, I would think that their rejection doesn't make sense if that's not the interpretation you're giving it. Certainly there's --

MR. LABARRE: Well, I, I think that's really why the, why she was relying on the secondary reference because that does have the concept of what they call distortion where some items of data may be expanded and other items of data then are moved as a result of that expansion. I think that was -- that's my interpretation of the rejection is that the Examiner recognized that Selker doesn't disclose either this magnification or this change is position and therefore, was relying on the Carpendale (phonetic sp.) reference for a teaching of those concepts.

JUDGE HOMERE: Well, well the rejection itself was focused primarily on Claim 1 and, the secondary reference was relied on for the repositioning as, as cited in Claim 1, but as we said that when you get to

Claim 35 or Claim 128 for instance, you don't really have that explicitly recited in those claims. So, I mean, when you put the two references, I mean -- I think for Claim 1, when you put the two references together it appears that where I could understand the argument that the combination itself does not teach the repositioning, but when you get to Claim 35, where that does not actually require the repositioning it appears to me the combination, not withstanding what the secondary reference teaches would appear to teach Claim 35 and 128 as well.

JUDGE MACDONALD: Let me, let me restate that. We didn't seem to see it quite as much in the secondary references as you do.

MR. LABARRE: Okay. Well, I think that it's coming back to the interpretation of the word position.

JUDGE MACDONALD: Yes.

MR. LABARRE: So, that's obviously one issue that, that will have to be resolved in your decision then is how you're going to interpret that term. I, I didn't want to jump ahead, but you also mentioned Claim 128.

JUDGE HOMERE: Yes.

MR. LABARRE: And, and I think that's a very specific claim.

JUDGE MACDONALD: Oh, you mean 128?

MR. LABARRE: Yes. And, basically what that claim covers is the idea that once you bring the cursor within a certain proximity of the menu bar, referred to as a threshold distance, the icon jumps up to a maximum size. So, it's an immediate going from a, what we call a default size, which is a minimum size, up to its maximum size.

JUDGE MACDONALD: Turn that, turn that off.

MR. LABARRE: And then it stays at that size even as you continue to bring the cursor closer. That's quite a bit different from the behavior that's disclosed in Selker because what Selker discloses is as you bring the cursor closer, the icon continues to grow in size, and that's what Figures 1, 2 and 3-A showed.

JUDGE MACDONALD: We, we -- I'll take this one. We actually had a lengthy discussion on this point. In our understanding of, of what is in the claim is that the Selker reference teaches exactly what's in the claim even though it does other things because the claim only has three steps. And, it doesn't preclude other things going on between the steps; for example, Selker starts out at a default height. So, it has, we believe, it showed Claim 1, first step. As you correctly stated, it then expands up to a, you know, a range of sizes. But, at the point where the cursor comes in contact with the icon in Selker, it stopped growing; there's a threshold. And, then as it goes inside the icon it doesn't get any bigger. It, it stops increasing. So, we, we looked through the reference and we looked at the claim and we said yes, there is in, in the disclosed invention it goes from, you know, from the default height to the maximum. And, Selker progresses from one to the other.

MR. LABARRE: Right.

JUDGE MACDONALD: But, we didn't see the progression was precluded by the claim language.

MR. LABARRE: Let me just clarify my understanding, then. What, what are you saying would be the threshold distance in Selker?

JUDGE MACDONALD: It is the boarder of the icon.

MR. LABARRE: So, when the, when the cursor touched the edge of the icon, that's the threshold?

JUDGE MACDONALD: That's the threshold.

MR. LABARRE: So, what the claim says is --

JUDGE MACDONALD: Even though your disclosure showed the threshold outside that area.

MR. LABARRE: Right.

JUDGE MACDONALD: The claim doesn't --

MR. LABARRE: Well, I, I don't --

JUDGE MACDONALD: -- say that the threshold --

MR. LABARRE: -- dispute that, that particular aspect of it. It's, it's the behavior, I think, that's recited in the claim. So, the claim says that reversing the order of the words a little bit, but upon detecting the cursor is within said threshold distance. So, that's the triggering act. It says, increasing the height of at least one of said items closest to said cursor from said default right to a fixed maximum.

So, in your interpretation, if the cursor is, is touching the icon at the point it reaches the threshold, then it doesn't go from the default to the maximum as a result of crossing that threshold. It's already at the maximum, as you explained. It stops growing at that point.

JUDGE HOMERE: But, you start, start off with the default height. I mean, once you start, I mean, you look at Selker, you started with the default height and, and you have a lot of things that occur in between. I mean a lot other sizes --

MR. LABARRE: Right.

1 JUDGE HOMERE: -- that occurs in between. And, then by the time
2you touch the tile, and it -- is at the maximum. So, why would that not
3include, encompass starting from the default height that, you know, you
4began with at the outset?
5 JUDGE MACDONALD: I, I think the point is being made is at the
6point the third step is occurring -- I'm sorry, the second step occurs, it's at a
7intermediate height at that point and the third step precludes an intermediate
8height.
9 MR. LABARRE: Right, because it's, it's that language upon
10detecting that the cursor is within said threshold distance. So, that, that is
11when the action occurs going from default to maximum. SO, in the example
12that you just gave, you start from the default when the cursor is still quite a
13ways away. I think they said -- they give like a 8 pints or something like
14that.
15 So, I think in your construction of the claim relative to Selker you
16have to first identify what are you going to call the threshold distance? And,
17then, does Selker teach you that when you hit that threshold distance,
18whatever point you want to take, and what we tried to bring out in the brief
19is you could call it Distance 8. You could call it Distance 2. It's something
20you have to define as the threshold distance. And, as Selker teached, when
21you hit that threshold distance you go from minimum to maximum. And, I
22think we all appreciate Selker doesn't teach that. It teaches a gradual that as
23you bring it closer, you continue to grow it. So, I think it's important in
24interpretation of Claim 128, make sure your're comfortable with what you're

calling the threshold, and then does it exhibit that claimed behavior when you hit the threshold?

JUDGE MACDONALD: Yes, it's important to recognize there's a difference, and is that difference obvious or unobvious.

MR. LABARRE: Right, right.

JUDGE BLANKENSHIP: Would you like a moment to sum up?

MR. LABARRE: Yes, actually, the, the main point that I wanted to bring out is that there are, there are two aspects of the Carpendale reference. One is that it's essentially non-analogous art. It doesn't deal with graphical user interfaces of the type we're talking about in the invention or in Selker where you're selecting a tile to perform some action.

With Selker -- I mean, what Carpendale is all about is a viewing tool. So, if you look for example at the title, it talks about a viewing tool. And, what it's concerned about is when you got large amounts of data, and you want to be able to view them related pieces of data in context. So, imagine if you would, you have a three dimensional spread sheet. It's lots of columns and lots of rows. So, in order to see the whole sheet on one screen, you've got to reduce it down to maybe 25 percent zoom ratio. So, you can't really make out what's in each cell. So, what basically Carpendale shows you is that by focusing on a particular cell, you can grow that one and the ones around it will grow because in the context of Carpendale it's important to understand --

JUDGE MACDONALD: Could I, could I stop you there and ask you to move on to your second point?

MR. LABARRE: Okay. It kind of relates in a sense that there's no reason to use that in the graphical user interface of the type that Selker is directed to because you're not concerned with contextual viewing when you put icons or buttons on a menu bar or task bar, they're in arbitrary order. You don't care which one is next to the other one. So, you don't have to view them in context. So, the whole idea behind Carpendale, which is to view data in a contextual setting really doesn't apply to Selker because, you know, I would imagine even though I'm on, on your computers you may have cut icons off the screen, but they're not grouped in any particular relationship where you need to see what's next to each one in order to comprehend what the icon is about. These are isolated icons to select individual programs, files, folders. So, the contextual viewing that is the crux of Carpendale really doesn't have any applicability to the menu icon or icon menu of Selker. So, that's what the rejection is lacking is a good identification of a reason for applying Carpendale to Selker. The Examiner gives some reasons in the Office Action and his answer or her answer, but all of those reasons are already met by Selker. You don't need to apply Carpendale to, to meet any of those.

JUDGE MACDONALD: So, ultimately, the issue with respect to this reference is, is there sufficient, a sufficient KSR based reason to even look at this reference? And, if you don't include this reference, are -- is there a sufficient teaching in the other references to meet the requirements of KSR?

MR. LABARRE: I, I think that's a good way to sum it up, yes.

JUDGE BLANKENSHIP: Thank you, Mr. LaBarre.

MR. LABARRE: Thank you.

JUDGE MACDONALD: We're off the record, now.

(Whereupon, the proceedings concluded.)